

## **REMARKS**

### **Amendments**

No amendments are made to the claims in this Reply. The above listing of the pending claims is provided for the Examiner's convenience.

### **Restriction Requirement**

As noted in the prior Reply filed October 29, 2010, a new Restriction Requirement was presented in the Office Action issued July 29, 2010. In the initial Restriction Requirement, set forth in the Office Action issued June 17, 2010, the claims were restricted into two Groups: Group I, claims 1-11, drawn to impregnated paper; and Group II, claims 12-16, drawn to a method of making impregnated paper. But, in the new Restriction Requirement in the Office Action issued July 29, 2010, the claims were divided into four Groups: Group I, claims 1-4, 7-11, and 17-19 drawn to impregnated paper; Group II, claims 12-16, drawn to a method of making impregnated paper; Group III, claim 20, drawn to impregnated paper; and Group IV, drawn to a method of making impregnated paper.

The new Restriction Requirement was traversed in the Reply filed October 29, 2010. However, the Final Office Action issued December 29, 2010 did not respond to applicants' traversal. Applicants herein again traverse the Restriction Requirement and request examination of all pending claims.

The Restriction asserts that Groups I-IV lack the same or corresponding technical feature. In support of this assertion, it is argued that applicants' claim 1 is obvious or anticipated by Wicher et al. (EP 0 697 622). However, the fact that the Office Action presents no rejection of claim 1 in view of Wicher et al. (EP 0 697 622) clearly contradicts the basis for the Restriction.

Moreover, merely providing a machine translation of Wicher et al. (EP 0 697 622) does not demonstrate how the Wicher et al. disclosure of anticipates or renders obvious applicants' claim 1. For example, the Restriction fails to demonstrate how the disclosure of Wicher et al. describes or suggests a paper with a high penetration resistance to fats and oils. Further, the Restriction does not demonstrate how the disclosure of Wicher et al. describes or suggests a paper that is produced from strongly beaten pulps with a degree of beating of 15<sup>0</sup>SR to 90<sup>0</sup>SR, and/or a paper that is internal sized with alkenyl succinic anhydride and/or

alkyl ketene dimers (AKD) and/or resin sizes, and/or an impregnating liquor which contains a binder system of 80 to 100 parts by mass of water-soluble binders. Additionally, the Restriction fails to demonstrate how the disclosure of Wicher et al. describes or suggests the binders recited in applicants' claim 1.

In addition, Group I and Group III are directed to the same subject matter, i.e., impregnated paper. The Restriction provides no rationale as to why the subject matter of Group I should be restricted from the subject matter of Group III. Similarly, Group II and Group IV are directed to the same subject matter, i.e., a method of making impregnated paper. The Restriction provides no rationale as to why the subject matter of Group II should be restricted from the subject matter of Group IV.

In view of the above remarks, it is respectfully submitted that the Restriction Requirement fails to set forth sufficient rationale to justify a restriction under PCT Rules 13.1 and 13.2. Withdrawal of the Restriction is respectfully requested.

#### **Information Disclosure Statement**

In the Final Office Action, contrary to the statement in the Reply filed October 29, 2010, copies of references B1-B4 were not provided with the Reply. Applicants apologize for the error. For the Examiner's convenience, copies of references B1-B4 are provided herewith, and are listed on the attached PTO Form-1449.

#### **Rejection under 35 USC 112, second paragraph**

Claims 1-4, 7, 9-11, 17-19, and 22-26 are rejected as being indefinite under 35 USC 112, second paragraph. This rejection is again respectively traversed.

In the prior Reply filed October 29, 2010, applicants argued that the objected to language is proper Markush language, and referred to MPEP §2173.05(h) in support thereof. In the Final Office Action, the Examiner responds to applicants' arguments by simply stating that the rejection is proper. See page 5 of the Office Action. However, this response does not explain why the objected to language is not a proper Markush group as described in MPEP §2173.05(h).

The rejection refers to the MPEP §2173.05(c). This section of the MPEP is entitled "Numerical Ranges and Amounts Limitations", and states that "Use of a narrow numerical range that falls within a broader range in the same claim may render the claim indefinite when

the boundaries of the claim are not discernible.” The examples of such indefinite ranges given in the MPEP are “(A) ‘a temperature of between 45 and 78 degrees Celsius, preferably between 50 and 60 degrees Celsius’; and (B) ‘a predetermined quantity, for example, the maximum capacity.’”

The objected to language in applicants claims is not a numerical range or an amount. Thus, MPEP §2173.05(c) does not apply. Further, applicants’ claims do not recite the language “preferably” or “for example,” as presented in the indefinite examples given in MPEP §2173.05(c).

The rejection also cites the decision in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), wherein the Board stated that “We do not consider the term ‘optionally’ to always result in the same degree of variability or indefiniteness as might result from the use of the phrase ‘such as.’” Applicants’ claims do not recite the phrase “such as.” Applicants claim 1 states what “said water-soluble binders are,” not what they may be.

The rejection also cites the decisions in *Ex parte Steigerwald*, 131 USPQ 74 (Bd. App. 1861), *Ex parte Hall*, 88 USPQ 38 (Bd. App. 1948), and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In *Steigerwald* the Board stated that “The ‘such as’ clause is improper in claims 5 to 11.” *Steigerwald* at 75. As mentioned above, applicants’ claims do not recite the phrase “such as.”

In *Hall*, the Board sustained the Examiner’s rejections that the phrases “such as urea formaldehyde glue” and “mineral wool such as rock wool or asbestos” to be indefinite. *Hall* at 39. As mentioned above, applicants’ claims do not recite the phrase “such as.”

In *Hasche*, the Board sustained the Examiner’s rejections that the phrases “which may be” and “such, for example as” as failing to properly define the claimed subject matter. *Hasche* at 482. Applicants’ claims do not recite the phrases “which may be” or “such, for example as”.

The language objected to in applicants’ claims is proper Markush language. The language in question properly sets forth a Markush group that defines the literal scope of “water-soluble binders” in the claim. See, MPEP 2173.05(h) “Alternative Limitations.”

The language of claim 1 is sufficiently clear so that one of ordinary skill in the art can readily determine whether a given embodiment is within is outside the literal scope of the claim. Nothing more is required under the statute. Withdrawal of the rejection is again respectfully requested.

**Rejection under 35 USC 102(b)/103(a) in view of Schoeller**

Claims 1-4, 7, 9-19, and 22-26 are rejected as being anticipated or obvious in view of Schoeller et al. (EP 0 545 043). This rejection is respectively traversed.

Firstly, applicants note that this rejection is applied against “Claims 1-4, 7, 9-19, and 22-26,” which includes withdrawn claims 12-16. Thus, clarification of the status of claims 12-16 is requested.

In general, Schoeller et al. disclose a base paper for use in photographic supports. The paper is made from recycled material or a mixture of recycled material and standard cellulose or photo cellulose. The pulp contains 5-100% recycled material.

Schoeller et al. do not discuss penetration resistance to fats and oils. Moreover, Schoeller et al. do not disclose or suggest how one would treat paper to provide high penetration resistance to fats and oils.

In the rejection, it is argued that Schoeller et al. (EP ‘043) disclose impregnating paper with a “water-soluble binder,” referring to pages 5-6 and Examples 1-3 (pages 8-12) of the English translation of Schoeller et al. (EP ‘043). The only reference by Schoeller et al. (EP ‘043) to polyvinyl alcohol is in Example 3 (page 12), where it is stated:

“The paper was in likewise a known way surface-sized with a solution, which contained 3.45% by weight polyvinyl alcohol, 4% by weight  $\text{CaCl}_2 \times 2\text{H}_2\text{O}$  and 0.53% by weight of fluorescent bleaching agent.”

This does not, however, disclose or suggest impregnating a paper with an impregnating liquor containing a binder system with 80 to 100 parts by mass water-soluble binders, in accordance with applicants’ claimed invention. Firstly, surface sizing refers to a surface treatment, i.e., the paper is sized on the surface. See, also, for example, Koskinen et al., WO 2004/111336 (copy enclosed), which describes a paper comprising a base paper and a surface size layer comprising an inorganic pigment and polyvinyl alcohol (PVA). The rejection does not indicate how such a surface treatment suggests impregnation of the paper.

Secondly, while polyvinyl alcohol is a water soluble polymer, it is not one of the water-soluble binders recited in applicants’ claim 1. As set forth in claim 1, the water-soluble binders are selected from ethylene-vinyl alcohol copolymers, acetalized ethylene-vinyl alcohol copolymers, acetalized polyvinyl alcohols, polyvinyl butyrals, cationically modified polyvinyl alcohols containing silanol groups, acetalized cationically modified polyvinyl

alcohols containing acetalized silanol groups, polyvinyl alcohols containing carboxyl groups, and mixtures thereof. The rejection fails to demonstrate where Schoeller et al. disclose or even suggest the use of any of these binders.

Polyvinyl alcohol is not a water-soluble binder in accordance with applicants' claim 1. For example, polyvinyl alcohol is not an acetalized polyvinyl alcohol such as polyvinyl butyral (PVB). See, e.g., applicants' Example 4.

The rejection fails to demonstrate where Schoeller et al. disclose or even suggest the use of any of the binders recited in applicants' claims. Furthermore, with regards to the asserted obviousness, the rejection presents no rationale as to why one skilled in the art would modify the paper of Schoeller et al. so as to use a binder in accordance with applicants' claimed invention.

In the rejection, it is argued that the claims are considered product-by process claims due to the recitation of strongly beaten pulps with a degree of beating of 15 °SR to 90 °S. It is unclear what is intended by this assertion. The recitation of strongly beaten pulps with a degree of beating of 15 °SR to 90 °S merely describes material used in making the paper. The recitation only characterizes the starting material used to make the paper as a product-by-process. The overall subject matter claimed is clearly a product, i.e., a paper impregnated with a specific impregnating liquor.

Moreover, asserting that the claims are "product-by-process" does not obviate the requisite showings for an obviousness rejection under 35 USC 103. The rejection makes the unsupported conclusion that any differences would have been obvious as a routine modification. Yet, no rationale/explanation is presented as to how routine modification of Schoeller et al.'s photographic base paper would lead one of ordinary skill in the art to paper having high penetration resistance to fats and oils in accordance with applicants' claim 1.

The rejection fails to set forth any reasoning why it would be obvious to modify the paper of Schoeller et al. to use a binder in accordance with applicants' claim 1. Additionally, the rejection presents no rationale as to why it would be obvious to modify the paper of Schoeller et al. so as to exhibit features in accordance with features recited in applicants' various dependent claims such as smaller subgenera of binders, crosslinking agents, concentration of the impregnating liquor, coating weight of the impregnating liquor, etc.

In view of the above remarks, it is respectfully submitted that the rejection fails to establish that the disclosure of Schoeller et al. anticipates the claimed invention in accordance

with 35 USC 102(b). In addition, in view of the above remarks, it is respectfully submitted that the disclosure of Schoeller et al. fails to render obvious the claimed invention in accordance with 35 USC 103(a). Withdrawal of the rejection is respectfully submitted.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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